

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF  
THE TTAB

Mailed:  
August 18, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Simi Winery, Inc. and Franciscan Vineyards, Inc.

v.

Mr. Container and Simi Global Corporation

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Cancellation Nos. 92030168; 92031424;  
92031728; 92031786 and 92031877

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John M. Rannells of Baker & Rannells for Simi Winery, Inc.  
and Franciscan Vineyards, Inc.

Edward M. Joffe for Sandler, Travis & Rosenberg, P.A. for  
Mr. Container and Simi Global Corporation

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Before Seeherman, Quinn and Walsh, Administrative Trademark  
Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Simi Winery, Inc. and Franciscan Vineyards, Inc.

(hereafter petitioner)<sup>1</sup> have petitioned to cancel four

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<sup>1</sup> The petition to cancel Registration No. 2219750 (Cancellation No. 92030168) was filed by Simi Winery, Inc. Subsequently Simi Winery, Inc. was merged with and into Franciscan Vineyards, Inc. As a result, Franciscan Vineyards, Inc. was joined as a party plaintiff. Similarly, because Mr. Container merged with Simi Global Corporation after the commencement of Cancellation No. 92030168, Simi Global Corporation was joined as a party defendant.

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registrations. These registrations issued to Mr. Container; subsequently, Mr. Container merged into Simi Global Corporation. Unless specifically noted, references to "respondent" in this opinion will mean Mr. Container, Simi Global Corporation, or both companies. One registration, No. 2219750, for the mark SIMI, is the subject of two cancellation actions. Cancellation No. 92030168 seeks to cancel Class 32 of this registration for "beverages, namely, powdered soft drink mix"; Cancellation No. 92031877 seeks to cancel Class 29 of this registration for "food seasonings, namely, bouillon cubes containing meat/poultry/vegetable extracts."<sup>2</sup> The other registrations are for SIMI DOCTOR (Registration No. 2220628, subject of Cancellation No. 92031786) for "baking soda";<sup>3</sup> SIMI TI MOTO (Registration No. 2226361, subject of Cancellation No. 92031728) for "seasoning";<sup>4</sup> and SIMI in stylized form, as shown below,

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<sup>2</sup> Issued January 19, 1999, from an intent-to-use application filed May 23, 1997; Section 8 affidavit accepted. It asserts first use and first use in commerce for the goods in Class 29 on June 13, 1998, and first use and first use in commerce for the goods in Class 32 on November 3, 1997. This registration also contains a third class, for "toiletries, namely, toothpaste" (Class 3); petitioner does not seek to cancel the registration in this class.

<sup>3</sup> Issued January 26, 1999, from an application filed May 18, 1998 and asserting first use and first use in commerce on February 11, 1998. Section 8 affidavit accepted.

<sup>4</sup> Issued February 23, 1999, from an application filed May 18, 1998, and asserting first use and first use in commerce on January 23, 1998. Section 8 affidavit accepted. The registration states that the English translation of the Patois term "ti" is "little" and the English translation of the Indonesian term "moto" is "seasonings." The registration also includes a disclaimer of exclusive rights to use "moto" apart from the mark as shown.

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(Registration No. 2389146, subject of Cancellation No. 92031424) for "breakfast foods, beverages, staple foods, condiments, and seasonings, namely, salt, spices, sugar, sauces, coffee, tea, cocoa, pasta, pastries, vinegar, mayonnaise, mustard, bread, relishes, flour, breakfast cereal, yeast, baking powder, baking soda, honey, and rice."<sup>5</sup>

The logo for 'Simi' is rendered in a large, bold, black serif font. The letters are thick and closely spaced, with a classic, slightly ornate design. The 'S' is particularly large and dominates the left side of the word.

The registrations were originally issued in the name of Mr. Container. This company subsequently merged with Simi Global Corporation.

Because the cancellation proceedings involved common questions of fact, the Board consolidated the proceedings.

As grounds for cancellation, petitioner has alleged that it is the owner of the mark SIMI and variations thereof as a trademark, trade name and service mark for a wide range of goods and services; that since prior to any date that may be claimed by respondent, petitioner has used its mark for wines and goods and services related thereto; that

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<sup>5</sup> Issued September 26, 2000, from an intent-to-use application filed August 10, 1998, and asserting first use and first use in commerce on December 11, 1998.

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petitioner owns a registration for SIMI for wines;<sup>6</sup> and that respondent's marks are confusingly similar to petitioner's mark when applied to the goods of the parties, such that respondent's registrations are likely to cause confusion or mistake or to deceive.<sup>7</sup>

Respondent denied the salient allegations of the petitions to cancel in its answers.<sup>8</sup>

### **Motion to Amend**

On August 23, 2004, after trial, petitioner moved to amend the pleadings in Cancellation No. 920314234 pursuant to Fed. R. Civ. P.15(b) to include "additional and/or alternative grounds for partial cancellation." Specifically, petitioner alleges that, when respondent filed its Allegation of Use (Amendment to Allege Use) in connection with the application which issued as Registration

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<sup>6</sup> Registration No. 1021644, issued September 30, 1975, from an application filed on November 16, 1973, and asserting first use in 1876 and first use in commerce in 1935; Section 8 affidavit accepted; Section 15 affidavit received; renewed twice. Petitioner also pleaded ownership of a registration for SIMI SENDAL and design for wine, and submitted a status and title copy of the registration. However, during the pendency of this proceeding the registration became due for renewal, and Office records show that the registration expired for failure to renew it. Therefore, we have given no consideration to this registration.

<sup>7</sup> All four registrations issued in 1999, and the petitions to cancel were filed within five years of the issuance of the registrations, so likelihood of confusion is an appropriate ground for cancellation. See Section 14(1) of the Trademark Act, 15 U.S.C. §1064(1).

<sup>8</sup> Respondent has listed an "affirmative defense," but this is actually an elaboration of the reasons for its denial that confusion is likely.

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No. 2389146 (for the stylized mark SIMI), it had not used its mark on all of the goods listed in the application. Therefore, petitioner asserts that the goods for which respondent had not used the mark should be stricken from the recitation of goods in that registration, and petitioner also asserts that "as the Allegation of Use filed by Registrant in support of and as the basis for the registration in issue was false, the registration should be cancelled."

Petitioner states that the information regarding respondent's use, or more correctly, lack of use, became known when, during petitioner's cross-examination of George Saati, respondent's president, petitioner's counsel asked Mr. Saati whether respondent sold various products under the mark SIMI, and Mr. Saati said no.

The Board, following its usual practice, deferred action on the motion until final hearing. Petitioner renewed its motion to amend in its main brief. In its responsive brief, respondent did not specifically oppose the motion. Rather, it acknowledged that, with respect to Registration No. 2389146, respondent "has not used the mark on [salt, sugar, sauces, coffee, tea, cocoa, mayonnaise, mustard, bread, flour, honey and rice] and has no opposition to having those goods removed from the registration." p. 4.

In its reply brief petitioner pointed out that

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respondent did not address petitioner's amended pleading to cancel the registration in its entirety as a result of filing a false Declaration of Use with the PTO." p. 1. It therefore requested that, in the event the registration was not cancelled on the ground of likelihood of confusion, it should be cancelled in its entirety as a result of respondent's filing a false declaration.

Rule 15(b) of the Federal Rules of Civil Procedure provides that "when issues not raised by the pleadings are tried by express or implied consent of the parties, they shall be treated in all respects as if they had been raised in the pleadings." We cannot say, based on the questions raised during cross-examination as to whether respondent had made use of the mark, that respondent was aware that the issue of fraud had been tried. Nothing was asked as to respondent's reasons for listing goods in the Amendment to Allege Use for which it had not used the mark that would have suggested that respondent's intent, one of the elements of fraud, was being questioned. Even after briefing, it appears that respondent did not consider that fraud was a potential ground; it is clear from respondent's statements that it believed that simply striking the goods for which the mark had not been used was sufficient to resolve the problem.<sup>9</sup> Moreover, we note that petitioner itself never

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<sup>9</sup> It should be noted that, if fraud is found on the basis that

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clearly indicated that it sought cancellation on the ground of fraud. It has merely referred to the Allegation of Use as being false and/or that respondent had made a false statement. Because petitioner's own cross-examination could as easily, and in fact could more easily, be viewed as a basis for simply striking from the registration those goods on which the mark had not been used, i.e., partially cancelling the registration, we cannot say that the issue of fraud was tried by implied, let alone express consent. Therefore, petitioner's motion to amend the pleading to add this ground is denied. However, because respondent has agreed to have certain items deleted from the registration, we grant petitioner's motion to strike such goods from the registration. The petition to partially cancel Registration No. 2389146 to remove from the identification "salt, sugar, sauces, coffee, tea, cocoa, mayonnaise, mustard, bread, flour, honey and rice" is granted. We deem the registration to include only "spices, pasta, pastries, vinegar, relishes, breakfast cereal, yeast, baking powder and baking soda."<sup>10</sup>

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an applicant for registration intentionally stated, in an Amendment to Allege Use, that it had used its mark on any of the goods in the identification when it had not, the registration as a whole would be cancelled. A registrant cannot cure fraud by simply deleting those goods for which its Amendment to Allege Use was false.

<sup>10</sup> We note that, in its reply brief, petitioner has objected to respondent as having treated, in its main brief, this registration as having been partially cancelled, and asserts that, for purposes of deciding the issue of likelihood of confusion, the identification should be considered as it was when the registration originally issued. However, since it was

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**The Record**

he record includes the pleadings and the files of the registrations sought to be cancelled. Also of record is the testimony, with exhibits, of petitioner's witnesses Ronald C. Fondiller, Assistant Secretary of Constellation Brands, Inc., petitioner's parent company; and Chris Francis Fehrstrom, Senior Vice President of Marketing at Franciscan Vineyards, Inc.; and of respondent's witnesses George Saati, president of respondent; Jose Damien, owner of Dixie Food and an exporter of respondent's goods; and Mel Dick, a partner in Southern Wine and Spirits of America, which is a distributor of petitioner's SIMI wines. Excerpts from a declaration by George Saati have been submitted pursuant to stipulation of the parties. Petitioner has also submitted four notices of reliance, consisting of a status and title copy of its pleaded registration; excerpts from The New American Bartender's Guide; copies of excerpts from certain printed publications; and copies of numerous third-party registrations.

The proceedings have been fully briefed, but an oral hearing was not requested.

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petitioner that sought partial cancellation of the registration after trial, and because respondent has consented to that request, thereby in effect stipulating to that relief, we think it appropriate to grant petitioner's request for partial cancellation prior to considering the issue of likelihood of confusion.



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We turn first to objections raised by petitioner in its reply brief. Petitioner asserts that respondent's brief is "replete with distortions and misstatements of the record, attempts to inject evidence into the record that respondent did not introduce during its trial period, and the introduction of inappropriate matter clearly intended to prejudice the record." Reply brief, p. 2. With respect to petitioner's specific objections, we will not strike that portion of respondent's brief which contains copies of its packaging, although we have given such evidence the limited probative value that it deserves. Further, we have based our decision on the evidence that is properly in the record, or on matters of which we may take judicial notice. In this connection, petitioner states that respondent has attempted in its brief to introduce evidence concerning Simi Valley, California. We point out that, even though no evidence about this geographic location is in the record, the existence of a geographical place is a proper subject for judicial notice. Finally, petitioner objects to respondent's discussion of laches. As previously noted, respondent did not raise laches as an affirmative defense. However, laches as being indicative of the lack of likelihood of confusion is one of the subparts of the du Pont factor<sup>11</sup> of the market interface between the

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<sup>11</sup> In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ

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parties. To that extent, we have considered respondent's arguments in our analysis of the issue of likelihood of confusion.

### **Facts**

Opposer Simi Winery, Inc. was acquired by Constellation Brands, Inc. and was merged into Constellation's wholly-owned subsidiary, Franciscan Vineyards, Inc., where it is now a division. Simi Winery was founded by two brothers with the surname Simi. The winery opened in Sonoma County, California, in 1880, and it has sold wine under the mark SIMI since the late 1800s continuously to the present day, except during Prohibition. Through most of these years, Simi had limited production. Its 1976 newsletter describes it as a boutique winery. Opposer provided sales figures for its wine sales starting in 1987. From 1988 through 1993, annual retail sales ranged from \$20.1 million to \$25.1 million. By 1996 sales had increased to \$30 million, and hit \$34.4 million in 2000. Wholesale sales reached \$23 million in 2003. The core group of SIMI wines sells for between \$15 and \$25 a bottle, with the upper tier wines selling for between \$25 and \$30, and the high end wines costing \$70. The retail sales figure of \$34.4 million for 2000 represented sales of 1.8 million bottles.

Depending on individual state laws, opposer sells its

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wines in grocery stores, restaurants, independent stores such as liquor stores and wine stores and club stores. It also sells its wine direct-to-consumer, with orders taken by telephone, over the Internet, and as a result of its newsletter. In addition, opposer operates a visitor center at its winery, where it offers a variety of merchandise, including wine, clothing items, wine-related items such as corkscrews and coasters, food-related items such as bread boards, and limited food items, in particular, olive oil and wine vinegar. Between 1999 and 2001, annual sales of merchandise at the visitor center amounted to \$130,000.

Opposer's annual advertising, promotional and public relations expenses for the years 1998-2000 were in excess of \$400,000; in 2003 they were over \$500,000, and in fiscal year 2004 they were \$450,000. These expenditures were for, inter alia, participation in consumer and wine trade events such as the Aspen Food and Wine Festival. Opposer advertises in newsletters that are produced by liquor and wine stores, such as The Wine House, which newsletter has a distribution of between 75,000 and 150,000 customers. At the time of Mr. Fehrnstrom's deposition in 2004, opposer was advertising its SIMI wines in "Bon Appetit" magazine; in the past it has advertised in newspapers and magazines such as "Time" and "Newsweek."

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Opposer and its wines have also been the subject of or mentioned in articles in magazines and newspapers.

Respondent Mr. Container, Inc. sells a variety of products under the mark SIMI, including grocery items such as powdered soft drink mix, macaroni and cheese, and red and white vinegar; stationery such as notebooks; and health and beauty items such as toothpaste and soap. Respondent markets its goods primarily to domestic wholesalers for resale in the Caribbean and Latin America and directly into neighboring countries. None of its goods is sold in the retail trade or marketing channels in the United States. Respondent had not heard of SIMI wines when it adopted the mark; it chose the mark because it wanted a four letter mark that would be easy to pronounce in a variety of foreign languages. The packaging for its products generally includes four languages: English, Spanish, French and Portuguese.

### **Standing**

Opposer, by making its registration of record, as well as the evidence regarding its use of the mark SIMI, has established its standing.

### **Priority**

Contrary to petitioner's assertion, because this is a cancellation proceeding in which both parties own registrations, priority is in issue. See Brewski Beer Co.

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v. Brewski Brothers Inc., 47 USPQ2d 1281 (TTAB 1998); compare, King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). That is, petitioner may not rely on its registration as it can in an opposition proceeding, but must establish that it has superior rights in its mark. Each party may, however, rely on its registrations to show use of its mark as of the filing date of the application which matured into the respective registration. Thus, petitioner's registration establishes that as of November 16, 1973, petitioner used the mark SIMI for "wines." Petitioner has also shown that, with the exception of the Prohibition period, when by law it could not sell wine, it has used the mark SIMI for wine since the late 1800s, and that it has used the mark for wine continuously since 1935.

Respondent's registrations establish that it made constructive use of SIMI for "beverages, namely, powdered soft drink mix" and "food seasonings, namely, bouillon cubes containing meat/poultry/vegetable extracts" on May 23, 1997; of SIMI in stylized form for "spices, pasta, pastries, vinegar, relishes, breakfast cereal, yeast, baking powder and baking soda" on August 10, 1998; of SIMI DOCTOR on "baking soda" on May 18, 1998; and of SIMI TI MOTO for "seasonings" on May 18, 1998. Respondent's president testified that it began using SIMI in 1996; that it first

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used the mark SIMI for the goods in its Registration No. 2219750 (SIMI in typed form) in early 1997, and that it used the mark for the goods in its other registrations in 1997-98. However, the first use date claimed by respondent in Registration No. 2219750 is June 13, 1998 for bouillon cubes, and November 3, 1997 for powdered soft drink mix. If a party wishes to show use earlier than that claimed in an application/registration, it must do so by clear and convincing evidence. Respondent's president's testimony, consisting only of the statement that "I think 1997, early 1997" and "The filing was in May, '97, but we were using before we filed," test. p. 7, is not sufficient to establish an earlier use date. Therefore, and because the May 23, 1997 filing date of respondent's registration is earlier than the first use dates claimed in this registration, we will treat the filing date as the constructive use date. As for the other registrations, the general comment of "'97, '98" is not sufficient to establish use earlier than the dates asserted in those registrations. Thus, we deem January 23, 1998 to be the first use of SIMI TI MOTO, February 11, 1998 to be the first use of SIMI DOCTOR, and August 10, 1998 (the filing date, which is earlier than the claimed first use date) to be the first use of SIMI in stylized form. Accordingly, petitioner has not only established its priority of use of SIMI for wine through its

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registration, but has shown that it has used its mark on wine since long prior to respondent's use of its various marks.

Petitioner has also asserted common law rights in the mark SIMI for a variety of goods. These goods are sold through the visitor center at opposer's Simi Winery in Healdsburg, California. Petitioner has submitted documentary evidence showing sales of various merchandise as early as 1996. In particular, petitioner has demonstrated that it has sold two food items, wine vinegar and olive oil, bearing the mark SIMI since that date. Such sales are rather limited, with gross sales in 1996 for wine vinegar amounting to only \$3,754.10 and sales for olive oil amounting to \$4,566,60. Although petitioner's common law rights in SIMI for vinegar and olive oil cannot be considered extensive in view of the small number of sales, and the restricted channel of trade, they do show that petitioner has priority not only with respect to wine, but with respect to wine vinegar and olive oil.<sup>12</sup>

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<sup>12</sup> Petitioner has asserted in its brief that it has sold a variety of SIMI-branded non-food merchandise at its visitor center, including pepper mills and salt and pepper shakers. There is no evidence that sales of pepper mills and salt and pepper shakers were made prior to respondent's use dates.

**Likelihood of confusion**

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, supra. See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

Because respondent's registrations are for somewhat different marks and different goods, we will first consider those du Pont factors that are applicable to all of the registrations.

We turn first to the factor of fame since fame of a plaintiff's mark, if it exists, plays a "dominant role in the process of balancing the DuPont factors". *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002), quoting *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

Although petitioner has used the mark SIMI on wines for a very long time, for most of its history its wine production has been limited. Petitioner's September-October 1976 newsletter (Fehrnstrom Exhibit 10) stated that "one hundred years ago Simi was a small, quaint stone winery with a limited production.... ..Today Simi is still a small, quaint stone winery with a limited production—though the term now



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used is 'boutique winery'...."<sup>13</sup>

Its retail sales in 1987 were \$15.6 million, while annual sales in the 1990s ranged from \$23.1 million to \$34.4 million. Petitioner did not attempt to give any context for these wine sales, although its witness was specifically asked how sales of SIMI wines compared to those of opposer Franciscan Vineyards, Inc.'s other wines. We note that the website of opposer's sister company, Canandaigua Wine, (Fondiller declaration Exhibit 1, submitted as Exhibit 1 to Fondiller deposition), describes its Dunnewood Vineyards as bottling "about 200,000 cases of premium table wines each year." This would amount to 2.4 million bottles of wine, as compared to the 1.6 million bottles of SIMI wine sold by petitioner in 1999 and the 1.8 million bottles it sold in 1999.

In Bose, supra, at 1309, the Court stated that "raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, but raw numbers alone in today's world may be misleading. .... Consequently, some context in which to place raw statistics is reasonable." Petitioner has failed to provide any context for its sales figures that would show that a

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<sup>13</sup> Although normally an article cannot be used to prove the truth of the statements made therein, here petitioner's characterization of itself having limited production must be considered an admission against interest, and therefore falls under an exception to the rule against hearsay.

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substantial number of people are familiar with its mark; and based on the limited information we do have with respect to the sales by Dunnewood Vineyards, on its face petitioner's sales figures do not appear to be substantial for the wine industry.

Petitioner's advertising and promotional expenditures of between \$400,000 and \$500,000 annually from 1998 through 2004 do not appear to be particularly large. Further, the number of advertisements in national publications appears to be rather limited. Petitioner mentioned advertising in only one nationally distributed magazine, "Bon Appetit," in 2004, and testimony about other national advertising was not very specific: "In the past, Simi Winery has advertised in newspapers, as well as other [than "Bon Appetit"] magazines, broad sort of circulation magazines, whether it's Time, Newsweek, et cetera." Fehrnstrom, p. 36. Petitioner did not submit any advertisements from these broad-circulation magazines, nor indicate how often such advertisements appeared. Nor is there any indication that petitioner has advertised its wines on television, which of course reaches the largest number of people. The promotional efforts that petitioner has most discussed are advertisements put in wine retailer newsletters, with the specific newsletter going to between 75,000 and 150,000 people; a mini-CD containing recipes that was attached to 2000 bottles of its wine;

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special events such as winery and restaurant dinners pairing wines with food; and participation in winery trade events to cause the press to become interested in writing about its wines. The dinner events are, to some extent, "preaching to the choir," since these events are advertised to members of petitioner's wine club and to people who have come to petitioner's winery and provided their addresses for such mailings.

Petitioner has also made of record a large number of articles that make reference to its SIMI wines and/or winery.<sup>14</sup> Most bear dates from 1990 through 1998.<sup>15</sup> A large number of these articles are from periodicals related to the wine industry. For example, the August 1997 issue of "Wine & Spirits" magazine has a story on "Sonoma's Italian Roots" which includes a section on the beginnings of the Simi Winery; a several page article in the August 1998 issue of

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<sup>14</sup> With the testimony of Mr. Fehrstrom opposer submitted an exhibit, No. 16, consisting of 320 pages of what purport to be press clippings. Some of the articles, as shown by the summary which was prepared by opposer's attorney and which accompanies the clippings, are not identified as to publication or date. Because Mr. Fehrstrom did not authenticate these particular articles, and they are otherwise unidentified, they have no or extremely limited probative value. The same is true for those clippings that were submitted as part of Exhibit 15 which do not bear an indication of source or date and were not authenticated by Mr. Fehrstrom as part of his testimony. Similarly, we have given no probative weight to articles that are not in English (and are not translated), or which appear to come from foreign publications.

<sup>15</sup> We note that, although Mr. Fehrstrom stated that, since 2002 when he joined the company, he made it a point of maintaining a history of all press clippings, the clippings that were submitted as part of Exhibit 16 were all dated prior to 2002 and, in fact,

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that same publication is all about the Simi Winery. The October-December 1998 "Quarterly Review of Wines" features "Simi's New-Look Wines." There is an article about new Simi wines in the August 11, 1998 "The Wine Report." The May 1996 issue of "Beverage & Food Dynamics" reviews various wines, including the 1994 Simi Chardonnay, while an article in the October-November "Insider's Wine Line" features Simi Winery.

Other articles are from trade journals. See, for example, "California Beverage Journal" July 1998 (review of various wines, including several releases from Simi Winery; "California Farmer," August 1998 (viticulture and grape vine diseases, which discusses research being done in a Simi vineyard; "The Beverage Analyst," January 1997 (Simi Winery wine maker dinner); "V&WM Magazine" (Vineyard & Winery Management), May/June 1995 (article on team winemaking at Simi Winery); and "Beverage Media," July 1995 (reporting a tasting of Simi wines at a sales meeting for Park Avenue Merchants).

Some articles appear to be from local papers. See, for example, "Spotlight's Wine Country Guide," July 1999 (article about the winery, wine tastings and tours); "Rohnert Park/Cotati, California," (October 24, 1997) (article titled "Simi noted for food as well as its wines")

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no clippings dated after Mr. Fehrstrom became employed by

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about the dinner events at the winery); "The Press Democrat" (Santa Rosa, CA), October 28, 1998 (article about Halloween-themed dishes prepared by chef at Simi Winery); "Russian River Recorder—An Official Publication of the Healdsburg Museum and Historical Society," Summer 1998 (article about Healdsburg's early Italian wine families, including the Simis); "Where Wine Country," Fall 1998 (wineries in Sonoma Country, with a brief reference to Simi Winery).

Although there are articles from non-California newspapers, there are relatively few of them. They include a review of "SIMI SONOMA COUNTY CHARDONNAY 1996" in the May 27, 1998 "Dallas Morning News"; an article in the July 30, 1998 "Boca Thursday Paper" (Florida) featuring Simi Vineyards and some of its wines; a listing of wines as gift ideas in the December 25, 1996 "Sun Journal" (New Bern, NC), in which a Simi Winery wine appears in a list of nine, and the same article printed in "The Arizona Republic" on December 23, 1996. There is also an article in the "Austin American-Statesman," February 8, 1995, in which twelve wines, including SIMI SENDAL, are recommended for Valentine's Day presents. A restaurant review that appeared in several Long Island, New York newspapers, e.g., "Three Village Times," Mineola, NY, mentions, in discussing the Piping Rock restaurant's wine list, that it offers a Simi

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opposer were submitted as part of his testimony.

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Chardonnay. An article in "The Birmingham News" (Alabama) of August 23, 1995 reports on newsletters provided by wineries, and mentions the "Simi News."

There are a few articles from national newspapers and magazines. In particular, the April 3, 1998 issue of "USA Today" features Simi Winery's chardonnay as a weekend wine choice, while the May 10, 1996 issue of that paper has an article about places to stay and eat in Sonoma Country that lists Simi Winery as one of six wineries that can be visited. A Simi wine was also mentioned in a "Tasting Panel Report" in the October 1995 issue of "Bon Appetit."

In some of the articles, "Simi" or the Simi Winery receives only a brief mention. For example, an article in the May 14, 1998 "Atlanta Journal" discusses food and wines of summer, and in the penultimate paragraph includes a quote from Mary Evely, who is identified as heading "the food service program at Simi Winery in Healdsburg [sic], Calif." The last paragraph suggests that if one wants a dry rosé, "try Simi's Rosé or Cabernet Sauvignon or another labeled with the French term vin gris or the Italian term rosato." Another article, in the July 24, 1998 "Oxnard Star," discusses an auction party at which more than 80 wineries would be pouring samples, and Simi is mentioned in a list of eleven. The June 1995 "Wine Enthusiast" merely includes

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Simi Reserve in a listing of 23 cabernets.<sup>16</sup>

Although there is no question that Simi Winery and SIMI wines have received some publicity through the years, we cannot conclude that this publicity, or petitioner's sales, advertising and use of the mark, has resulted in SIMI having become a famous mark for wine. Melvin Dick, a partner in the largest wholesale distributor of wines and spirits in the world, and whose company has represented petitioner's brands for thirty years, could say only that the wine is "quite well known to people who appreciate fine wine."

p. 20. Being quite well known to connoisseurs of fine wine is different from being famous to the wine-buying public.

After thoroughly reviewing all of the evidence, we find that it is insufficient to support a finding that SIMI is a famous mark for wine. In view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, we think that it is the duty of a plaintiff asserting that its mark is famous to clearly prove it. Although wine connoisseurs may be well aware of the Simi Winery and the SIMI brand, the

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<sup>16</sup> Petitioner has also made of record an article from the April 2003 issue of "Wine & Spirits" that reports a survey of restauranteurs that asked them for the ten bestselling wines during the last three months of 2002. We give no weight to the results of this survey, since such results would be hearsay if we were to consider the article for the truth of the statements made therein.

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universe of wine purchasers in the United States is far larger than those who study wine guides or who are interested in reviews of the latest wine releases.

We do find, however, that the evidence submitted is sufficient to show that SIMI has achieved recognition as a mark for wine. Thus, any surname significance or geographic significance that might once have attached to the mark has long since disappeared, and SIMI must now be considered a distinctive mark for wine.<sup>17</sup> Moreover, respondent has not submitted any probative evidence of third-party use of SIMI marks. In this connection, we note the testimony of George Saati, respondent's president, that he had to adopt the domain name "www.mrsimi.com" because "simi" was taken. Mr. Saati did not provide any details of uses of "simi" as a domain name, let alone as a trademark, and in particular he gave no information as to the goods or services with which such domain names or marks might be used. Thus, the record reflects no third-party use of SIMI as a trademark for goods or services related to those of petitioner.

Accordingly, we find that the factor of the strength of the mark favors petitioner, but not to the extent that it would if SIMI were a famous mark.

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<sup>17</sup> We take judicial notice that "Simi Valley" is a suburb of Los Angeles, located in Ventura County. See The Columbia Gazetteer of North America © 2000. The Board may take judicial notice of entries in dictionaries and other standard reference works. In



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With respect to the factor of the channels of trade, all of respondent's identified goods are ordinary grocery items that may be sold in supermarkets and other retail grocery stores. We recognize that respondent currently exports all of its goods to Caribbean and Latin American countries, and does not sell to consumers in the United States. However, it is well established that the question of likelihood of confusion in a proceeding such as this must be determined based on an analysis of the mark as applied to the goods and/or services recited in the respondent's registration vis-à-vis the goods and/or services recited in the petitioner's registration, rather than what the evidence shows the goods and/or services to be. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Thus, we must deem respondent's goods to be sold in all appropriate channels for such products, including supermarkets and other grocery stores. As for petitioner's wine, the record shows that in a substantial number of states wine may also be sold in supermarkets and grocery stores.

As a result, we must deem both petitioner's identified wine and respondent's identified goods to be sold in the same channels of trade. At the same time, however, we recognize that a wide variety of goods are sold in

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re *Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 n. 4

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supermarkets and grocery stores, and the mere fact that food products and wine may be sold in such stores does not necessarily establish that such goods are related.

"Notwithstanding these common trade channels, it has often been stated that there can be no 'per se' rule that all food products are related goods by nature or by virtue of their capability of being sold in the same food markets, (i.e., the modern supermarket environment with its enormous variety of food, cleaning, paper and other products stocked and offered for sale)." *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169, 1171-72 (TTAB 1987). Therefore, unless, as discussed infra in connection with the specific goods in each registration, petitioner can show more of a connection in channels of trade than simply that the goods are all sold in supermarkets/grocery stores, this factor of the same trade channels favors petitioner only slightly.

As for conditions under which and buyers to whom sales are made, the consumers for petitioner's wine and respondent's various food products are the public at large. Although some of the purchasers of wine may be discriminating, wine is not such an expensive product that the public in general must be considered to be careful purchasers. Further, the grocery items identified in respondent's registrations are all rather inexpensive items

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(TTAB 2001).

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that may be purchased without great deliberation. Thus, this factor favors petitioner.

With respect to the factor of evidence of actual confusion, and the related factor of length of contemporaneous use without confusion, because respondent exports all of its goods, there has clearly been no opportunity for confusion to occur. Therefore, these factors are neutral.

We now turn to the individual registrations/classes that petitioner seeks to cancel. First we consider the registration for SIMI in stylized form for a variety of goods. We focus our analysis on the item "vinegar" which is included in the identification in that registration because likelihood of confusion must be found if the public is likely to be confused by use of respondent's mark on any of the items in the identification of goods. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 209 USPQ 986 (CCPA 1981).

Respondent's identification of "vinegar" would encompass "wine vinegar," which for several reasons must be considered related to petitioner's wine. First, because wine vinegar is made from wine, consumers are likely to believe that, if wine vinegar and wine are sold under the same or confusingly similar marks, both products emanate from the same source. Second, Melvin Dick, a witness called

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by respondent, testified that olive oil and vinegar are both part of the fine wine experience, thereby suggesting that such goods are all related. Third, the fact that petitioner itself has sold wine vinegar (and olive oil) under the mark SIMI since prior to respondent's first use of the mark for these goods further supports Mr. Dick's statement, and also shows the relatedness of the goods. Fourth, petitioner has made of record third-party registrations which also establish that wine and vinegar are related goods. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

At this point we must comment on the "approximately one hundred" (petitioner's main brief, p. 23) third-party registrations submitted by petitioner. Although petitioner quoted the language of Trostel in discussing these registrations, it ignored the requirement that the registrations must be based on use in commerce in order to be probative. Our review of these registrations reveals that the vast majority are based on Section 44 of the Trademark Act, rather than on use in commerce. Of the registrations that are based on use in commerce, however, many do include both wine and vinegar in their

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identifications of goods. See, for example, Registration No. 2312053 for VIANSA, No. 2297290 for CARMEL's CHOICE, No. 2203786 for CANARIO and design; No. 2130614 for FELICITAS and design, No. 2198757 for FATTORIA SAN LEONINO and design, No. 1828418 for IL FORNAIO, No. 1401427 for BADIA A COLTIBUONO and No. 1286155 for HONG MEI and design. These registrations are sufficient to demonstrate the relatedness of vinegar and wine.<sup>18</sup>

In addition to the relatedness of petitioner's wine and respondent's vinegar, petitioner also has shown that it has prior common law rights in SIMI for vinegar. Petitioner's vinegar and respondent's identified vinegar must be deemed to be legally identical goods. Although petitioner's common law rights in its mark for wine vinegar are limited to sales at its winery, consumers who have been exposed to SIMI wine vinegar at the SIMI winery visitor center and who then encounter wine vinegar under respondent's stylized SIMI mark

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<sup>18</sup> We note that some of the use-based registrations are in the nature of house marks or merchandising marks which cover a wide range of goods. Because of this, such registrations are of no probative value in demonstrating that all the goods listed therein are related, and we have not considered them in reaching our conclusion that vinegar and wine are related goods. See, for example, Registration No. 2601490 for AIOLI for goods and services in 8 classes, and including such varied goods as grass seeds, animal feed, cigarette holders, deer meat, ice cream and freight transportation of goods by means of train, truck, ship and air; Registration No. 2344538 for SYSCO for goods and services in 22 classes, including floor cleaner, insecticides, neon signs, elastic back supports, toilet paper and financial management services in the health care industry; and No. 1884513 for PEBBLE BEACH for goods and services in 9 classes, ranging

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in a grocery store are likely to assume that petitioner has expanded the trade channels for its goods, and is now selling its vinegar in retail stores.

This factor of the similarity of the goods favors petitioner.

As for the marks, although respondent's registration is for a stylized form of SIMI and petitioner's mark appears in standard character form, the words themselves are identical. Further, the protection accorded to petitioner for its standard character registration would include the slightly stylized version of SIMI that is respondent's mark. Accordingly, we find that petitioner's mark and respondent's mark are legally identical in appearance, and identical in pronunciation, connotation and commercial impression. This factor favors petitioner.

As noted previously, respondent has asserted laches in connection with the du Pont factor of the market interface between the parties, as being indicative of a lack of confusion. Respondent bases this claim on the fact that, when respondent's then-application was published for opposition, petitioner obtained extensions of time to oppose, but did not actually file an opposition. Respondent asserts that the failure to file an opposition indicates that petitioner "surmised that no likelihood of confusion

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from shampoo to photograph albums to plaques to golf putters to

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between its trademark and the then applicant's existed."

Brief, p. 22. We disagree. Respondent has pointed to no case law that stands for the proposition that the failure to file an opposition, whether or not an extension to oppose had been filed, demonstrates that the potential opposer concluded that confusion was not likely. Moreover, petitioner filed its first request for an extension of time to oppose on October 14, 1999; the subject registration issued on September 26, 2000; and petitioner filed its petition to cancel on December 28, 2000. We cannot conclude from the very short time that elapsed between these events that petitioner's decision to bring a cancellation proceeding rather than file an opposition shows that petitioner had previously determined that confusion was not likely, nor can we find that this decision by petitioner indicates a lack of confusion.

As for the remaining du Pont factors, to the extent that the parties have discussed them, they have merely reiterated the arguments that they made in connection with those du Pont factors we have previously discussed, and we will therefore not repeat them here.

The fundamental inquiry in the likelihood of confusion analysis goes to the cumulative effect of differences in the essential characteristics of the goods and differences in

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wine.

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the marks. See *Interstate Brands Corporation v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151 (CCPA 1978); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). Here, we find that the factors of the similarities of the marks and the similarities of the goods strongly favor petitioner. When we also consider the other du Pont factors that favor petitioner, we have no doubt that respondent's use of its stylized SIMI mark for vinegar is likely to cause confusion with petitioner's SIMI mark for wine, as well as with its SIMI mark for wine vinegar. Accordingly, the petition to cancel Registration No. 2389146 is granted.

This brings us to a consideration of the petition to cancel Class 29 of respondent's registration for SIMI, in standard character form, for the goods identified as "food seasonings, namely, bouillon cubes containing meat/poultry/vegetable extracts."

As we have previously stated, there is no per se rule that all food products are related. There are clear differences between wine and bouillon cubes. They are made from different products and have different purposes. Petitioner asserts that petitioner's and respondent's goods are related because wine may be served with and/or paired



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with food, and may be used "as an ingredient in food recipes (as are condiments and seasonings)" brief, p. 14; and because condiments and seasonings are ingredients in mixed drinks, including wine-based mixed drinks. In making these arguments, petitioner has discussed respondent's goods in general, using terms such as "condiments" and "seasonings" to refer to them, rather than analyzing this factor in terms of the specific (and different) goods that are recited in the different registrations that petitioner seeks to cancel. Thus, petitioner has not pointed to any specific evidence regarding bouillon cubes and wine to support its argument that these goods are related.

Moreover, in our review of the extensive evidence submitted by petitioner, we have found nothing that discusses the pairing of wine and bouillon. Although there are menus from various wine dinners that show, for each course, the particular wine that goes with the dish for that course, the food items listed are for the prepared food, and they do not indicate that bouillon is an ingredient in the dish, let alone a featured ingredient. See, for example, the listing of The Bounty of Harvest dinner, scheduled for October 6, 2001, which describes the menu as including "roasted beef tenderloin with a mushroom-cabernet sauce and a terrine of autumn vegetables." The Vintner's Table Cookbook, written by petitioner's former executive chef Mary

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Evely, contains an exhaustive listing of food affinities for particular wines. For example, the Sauvignon Blanc Profile lists herbs and spices such as cilantro, oregano and cumin; sauces such as citrus and vinaigrettes; cheese and nuts such as fresh goat cheese; seafood such as scallops and smoked fish; meat such as chicken; and vegetables and fruits such as artichokes and lettuces. It also has an equally detailed list of food/wine conflicts. However, in none of these pairings or conflicts does bouillon or bouillon cubes appear.

The best we can say is that some of the recipes appearing in The Vintner's Table Cookbook list broth or stock as an ingredient in a dish and also suggest the wine that may be served with it. For example, a recipe for white bean and sweet red pepper salad with fennel includes "5 cups vegetable stock or 1 can vegetable broth" (along with, inter alia, red onion, basil, bay leaf and lemon juice), and states that it matches with the texture of Chardonnay.

We also note that some recipes in The Vintner's Table Cookbook and on petitioner's sister company's website include, as ingredients, wine and broth or stock. For example, a recipe for risi e bisi lists "fresh chicken broth or canned low-salt chicken broth" and Sauvignon Blanc (along with, inter alia, chopped onion, unsalted butter, prosciutto and green peas); a recipe for salmon steaks with saffron-

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onion sauce includes "unsalted chicken stock or reduced-salt chicken stock" and Chardonnay (along with, inter alia, bacon, chervil leaves and saffron).

Aside from the fact that these recipes do not call for the actual goods, bouillon cubes, that are identified in respondent's registration, the inclusion of broth or stock as a minor ingredient in a recipe that also calls for wine, or in a dish that may be served with wine, is not a sufficient basis to show that bouillon cubes and wine are related goods. Certainly petitioner has not shown that bouillon cubes and wine are complementary goods, or have complementary uses. See *In re Mars, Inc.*, 741 F.2d 395, 222 USPQ 938 (Fed. Cir. 1984) (no confusion found between CANYON for candy bars and CANYON for fresh citrus fruit).

Petitioner has also submitted recipes for 118 mixed drinks, taken from The New American Bartender's Guide. After an exhaustive review of these recipes, we could find none that includes wine and bouillon as ingredients for the same drink. In fact, there are only a few drink recipes that contain bouillon, namely, the Bull Roar, which contains beef bouillon, beef consomme or beef broth, along with vodka, Bovril beef extract, Tabasco sauce, A-1 sauce, Worcestershire sauce, and white pepper; the Bull Shot, which contains, inter alia, beef consomme or beef bouillon and vodka; the Gazpacho Macho, which contains, inter alia, beef

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bouillon, vodka or tequila, and gazpacho soup; the Creole Cup, which contains, inter alia, rum and beef bouillon or consomme; the Beef and Bourbon, with bourbon and beef consomme or bouillon; the Celtic Bull, with Irish whiskey and beef consomme or bouillon; El Toro Sangriento, with tequila and beef consomme or bouillon; the Steaming Bull, with tequila and beef consomme or bouillon; and two variations of the Bloody Mary (Bloody Bull with beef bouillon; Cock 'n' Bull Shot with chicken consomme and beef bouillon). Many of these drinks appear to have the same recipe, with the exception of the primary liquor ingredient.

Petitioner argues that "any person making mixed drinks at home and any bartender will necessarily require many of the same ingredients as those recited in the registrations which are the subject of this proceeding." Brief, p. 18. We disagree. The guide from which these recipes are taken appears to contain any recipe that one might think of for a mixed drink, including many that are quite exotic. It is not evident to us that ordinary consumers making mixed drinks at home, and even most bartenders, would be aware of these oddly named drinks and their ingredients. More importantly, the fact that a particular ingredient might be used in an alcoholic drink that does not contain wine does not demonstrate that the ingredient and wine are related goods, any more than two different ingredients, used for

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different recipes, would be related simply because they both might be found in the same kitchen.

Petitioner has also submitted evidence from various food-oriented magazines to show that different food items and wine are advertised in the same magazines. However, petitioner has not pointed to any advertisements in these submissions for bouillon or bouillon cubes. Similarly, the evidence regarding gift baskets that contain wine along with other ingredients (thereby showing that the goods are sold not just in the same channels of trade, but together), does not indicate that bouillon is included among the contents. See summary of ingredients at p. 21 of petitioner's brief.

Finally, after thoroughly reviewing the third-party registrations, of those that we consider probative (see discussion, supra), the only ones that include both wine and broth are Registration No. 2203786 for CANARIO and design (beef broth, chicken broth and vegetable broth) and Registration No. 2648516 for a stylized D (broths, chowders, soups, vegetable and beef stocks). However, the latter registration is owned by Draeger's Super Markets and may be a house mark; the identification also includes "cooking schools."

There are five registrations that list "beef extract," and respondent's bouillon cubes are identified, in part, as containing meat extracts. Of these registrations, two are

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owned by a single entity (Cipriani Group, Inc.). The remaining three registrations were all filed by foreign companies. One of the registrations, No. 2273272 for SEREGO ALIGHIERI in Classes 29, 30 and 33, appears to identify the goods by class headings.<sup>19</sup> Two registrations, No. 2104535 for MARCHESI INCISA DELLA ROCCHETTA and No. 2237004 for DEMEL and design, were originally filed under Section 44 of the Act, and subsequently amended to claim use in commerce. The MARCHESI registration, in particular, appears to use class headings as the identification of goods, and includes, inter alia, grass seeds, dried plants, animals and animal food stuffs, meat, fish, poultry, game, meat extracts, jellies, tea, cocoa and treacle. Such registrations, which cover such a wide range of goods, are of little probative value in demonstrating that all the goods listed therein are related.

In short, there are too few third-party registrations which have probative value for us to conclude that wine and bouillon cubes are likely to emanate from a single source under a single mark.

Thus, after a thorough review of the evidence submitted by petitioner to show that wine and bouillon cubes are

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<sup>19</sup> For example, the goods in Class 29 are identified as "meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and dairy products excluding ice cream, ice milk and frozen yogurt; edible oils and fats."

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related, we find that petitioner has failed to establish this point. There is simply no basis on which we can conclude that consumers would expect that bouillon cubes would emanate from the same source as wine, even if they were sold under the same or confusingly similar marks. The factor of the similarity or dissimilarity of the goods strongly favors respondent.

As previously noted, in the likelihood of confusion analysis two key considerations are the similarities between the marks and the similarities between the goods and/or services. Because petitioner has failed to show that the goods are related, it cannot prevail, despite the fact that the marks are identical, and despite the other du Pont factors that favor petitioner. The petition to cancel Class 29 of Registration No. 2219750 (Cancellation action No. 92031877) is dismissed.

Petitioner is also attempting to cancel Class 32 of Registration No. 2219750 for SIMI in standard character form, for goods identified as "beverages, namely, powdered soft drink mix." However, again we find the evidence submitted by petitioner woefully lacking in terms of demonstrating that wine and powdered soft drink mix are related. Petitioner has pointed to no alcoholic beverage recipes which include both wine and powdered soft drink mix. Indeed, we have found no beverage recipes whatsoever that

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call for powdered soft drink mix. (We point out that respondent's identification is limited to powdered soft drink mix; therefore, the use of carbonated soft drinks, such as mixers, in alcoholic beverages has no relevance here.) Nor has petitioner identified any recipes for food in which wine and powdered soft drink mix are ingredients, or any reference to pairing wine with powdered soft drink mix or with foods or drinks containing powdered soft drink mix. Further, we have not found, in the materials submitted, any evidence that powdered soft drink mix is included in gift baskets that also contain wine.

Of the probative third-party registrations, we have found two (for SUN MAID and for a design mark), both owned by Sun-Maid Growers of California, that originally listed, inter alia, wines and soft drinks. USPTO records show that, as a result of that registrant's filing its Section 8 affidavits of use, wines and soft drinks have been deleted from those registrations. There is also a registration, No. 1553878 for SPORTSERVICE, that includes "soft drinks" and wines. However, this registration also is for, inter alia, hamburger sandwiches, french fries, management services rendered to owners of bowling alleys, race tracks, theaters and baseball stadia, and retail store services in the fields of bait, tackle, fuel, groceries and animal feed. It appears from the identification that the registrant offers



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soft drinks in the context of snack bar food services. In any event, "soft drinks" is not the same as powdered soft drink mix, and even if we were to consider all three registrations as being for substantially the same goods as respondent's, the limited number, representing only two entities, is not sufficient to demonstrate that wine and powdered soft drink mix emanate from the same source.<sup>20</sup>

Petitioner has pointed to certain cases which it contends support its position that wine and powdered soft drink mix are related goods. In its discussion of *Bongrain International (American) Corporation v. Moquet Ltd.*, 230 USPQ 626 (TTAB 1986), petitioner states that "it is a matter of common knowledge that wine and soft drinks and coffee (often served with sugar) and tea (often served with honey) are served at many of the same social occasions and at the same meal, and that desert [sic] wines are often served with deserts [sic] such as pastries." Brief, p. 24. This quote appears to be petitioner's; all that was said in Bongrain

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<sup>20</sup> There is one other use-based registration that includes non-carbonated soft drinks, Registration No. 2250314 for INSTA-HEAT. However, this registration does not include "wines" per se. Although it includes sake, which is a rice wine, and hard cider, which is alcoholic, we do not view this registration as demonstrating that wine and powdered soft drink mix emanate from a single source. The registration covers not only food items, but also cold and flu medicines and infant formula. Further, we note that the mark suggests something that is heated, and all of the goods listed in the registration are products that can or should be served warm.

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was "it is a matter of common knowledge that wine and cheese are often served together at parties."

We find it somewhat ironic that petitioner essentially asks us to take judicial notice that wine and soft drinks are served at the same social occasions and at the same meal, when petitioner objected to respondent's reference, without evidentiary support, to Simi Valley, California, even though the existence of a geographic place is a suitable subject for judicial notice. Whether or not wine and soft drinks might be served at the same social occasions, there is no evidence that either powdered soft drink mix or soft drinks made from such a mix and wine are served at the same social occasions or meals. Nor do we think that this is a matter of common knowledge, such that we can take judicial notice of it.<sup>21</sup>

Petitioner also relies on General Foods Corporation v. Monarch Wine Company of Georgia, 142 USPQ 521 (TTAB 1964). However, this case has no precedential value. It was published only in digest form, and does not indicate the

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<sup>21</sup> See Bongrain, supra at 628, n. 4, "Opposer, in addition to relying on its affidavit, has also requested that we take judicial notice of the facts that wine and cheese are both sold through gourmet stores and supermarkets; that they are often purchased in the same shopping trip by consumers; and that they are often consumed at the same social event. We agree with applicant, who has objected to the request, that the shopping patterns of purchasers and the channels of trade of particular goods are factual questions which are appropriately established through the introduction of evidence rather than by judicial notice."

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facts on which the determination was based. See *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, n. 9 (TTAB 1992); *In re American Olean Tile Co.*, 1 USPQ2d 1823 (TTAB 1986); and TBMP § 101.03 (2d ed. rev. 2004).

As for the other cases cited by petitioner in which confusion was found between wine and sodas or fruit juice and wine because sodas and fruit juices could be used as mixers, these cases are distinguishable because there is no evidence that powdered soft drink mix is used as a "mixer" with wine or other alcoholic beverages. Moreover, in the case of *In re Jakob Demmer KG*, 219 USPQ 1199 (TTAB 1983), in which confusion was found between GOLDEN HARVEST for apple cider and for wine, there are the additional distinguishable factors that apple cider can be sold in alcoholic as well as non-alcoholic form, and apple juice can be used to make wine.

However, one point made in Jakob Demmer is applicable here, and that is the principle that "there is and should be no per se rule that alcoholic and non-alcoholic beverages are related products." Id. at 1201. We add that the mere fact that both petitioner's and respondent's goods can loosely be described as beverages is not a sufficient basis on which to find that they are related. See *UMC Industries, Inc. v. UMC Electronics Co.*, 207 USPQ 861 (TTAB 1980), and cases cited therein.

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In view of petitioner's failure to demonstrate the relatedness of wine and soft drink beverage mix, as with the petition to cancel Class 29 of Registration No. 2219750, we find that there is no likelihood of confusion with respect to respondent's use of SIMI for its Class 32 goods, despite the fact that the marks are identical, and despite the other du Pont factors that favor petitioner. Consequently, Cancellation action No. 92030168 is dismissed.

The next registration which petitioner seeks to cancel is Registration No. 2220628 for SIMI DOCTOR for baking soda. Here, again, petitioner has utterly failed to show that the parties' goods are related. In fact, petitioner has pointed to no recipes in which baking soda is even used as an ingredient, or to any third-party registrations which even include baking soda and wine, or any gift baskets which contain baking soda as well as wine. Nor is there any other evidence from which we can conclude that baking soda and wine are complementary products, or that consumers would expect them to emanate from a single source. Petitioner has not even argued in its brief how baking soda might be related to wine.

Petitioner has, however, asked that the Board take "judicial notice of the fact that baking soda has long been used and prescribed for many matters, perhaps best known being, cleansing, odor removal, and protection from chaffing

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[sic] and rash." Brief, p. 11. Again, we find it ironic that petitioner would ask us to take judicial notice of this, when it objected to respondent's mention of Simi Valley in its brief. We decline to take judicial notice of this so-called fact; we do not believe that it is a matter of common knowledge that baking soda is prescribed or used in these manners. Even if we were to take such notice, however, non-food uses of baking soda such as cleansing and rash protection make the product even more dissimilar to wine.

Because on this record we must find that the goods are not related, even use of the same or a confusingly similar mark for both products would not be likely to cause confusion. But here the marks are not confusingly similar. Petitioner's mark is SIMI; respondent's mark is SIMI DOCTOR. The word DOCTOR in respondent's mark is a somewhat strange element and therefore noticeable and eye-catching, and its presence creates a mark that is distinctively different from SIMI in appearance, pronunciation, connotation and commercial impression.<sup>22</sup>

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<sup>22</sup> Petitioner had argued that, because baking soda has health care uses, the additional element DOCTOR in respondent's mark is suggestive and entitled to less weight in the comparison of the marks. Even if we were to accept petitioner's contention that baking soda has cleansing and anti-chafing applications, the term DOCTOR in respondent's mark actually emphasizes the differences in the goods, in that DOCTOR suggests the non-food uses of baking soda. Moreover, this suggestive meaning of DOCTOR (a connotation that is totally lacking in SIMI per se) causes SIMI DOCTOR to

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After weighing all the relevant du Pont factors, we find that petitioner has failed to prove that SIMI DOCTOR for baking soda is likely to cause confusion with SIMI for wine (or for any of the goods for which petitioner has common law rights). The petition to cancel Registration No. 2220628 is dismissed.

The final registration that petitioner seeks to cancel is Registration No. 2226361 for SIMI TI MOTO for seasonings. Turning first to the goods, respondent's goods are broadly identified as "seasonings." According to the testimony of Mr. Saati and the exhibits introduced therewith, the actual item on which respondent uses the mark is MSG. However, because the identification is not so limited, we must view the registration as encompassing spices, including salt and pepper.

A review of the evidence shows that spices may be used in the same recipes in which wine is used, or may be used to make meals with which wine is served. The "food affinities" section of The Vintner's Table Cookbook even lists spices that go well with particular types of wine, e.g., white pepper is a food affinity of chardonnay; cinnamon is a food affinity of rosé and blush wines. Clearly, spices and wine may be used in cooking the same recipes, and wine may be

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differ significantly from SIMI in connotation and commercial impression.

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served at a meal in which spices are ingredients of the food. However, spices are used so universally in cooking that we cannot conclude the goods are related simply because of this.

As noted previously, petitioner has made of record excerpts from magazines that show advertisements for food items and advertisements for wine appear in the same publication. The only advertisement that we have found that is arguably for a seasoning is one for Tabasco sauce in the May 2003 issue of "Food & Wine" magazine, Exhibit 5 to petitioner's third notice of reliance. (The term "seasonings," as that identification is interpreted, does not include sauces or condiments.) A single advertisement for Tabasco sauce that appears in a magazine in which advertisements for wine appear elsewhere is not sufficient to demonstrate that seasonings and wine are related goods.<sup>23</sup>

There is also an article entitled "What Do You Drink with Curry?" from the September 2001 issue of "Bon Appetit" (Exhibit 3 to petitioner's third notice of reliance); it discusses wine pairings with dishes from non-European cuisines, as well as from Greek cuisine. Two pages of the

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<sup>23</sup> On the other hand, a single advertisement in which two products are advertised together, such as the one in the May 2003 issue of "The Soul of Mexico" (Exhibit 9 to petitioner's third notice of reliance), in which Dannon yogurt and Dole pineapple chunks are advertised together, would have some probative value to show relatedness of goods.

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article are missing, but the portion that is available discusses such things as a particular restaurant's "signature dressing, a lively combination of lemon, olive oil, oregano, garlic, salt and pepper" and mentions a "crisp, lemon-and-mineral-tinged white wine from Boutari" that the restaurant's general manager would recommend with it. Again, the mere fact that wine may be chosen so that it would work well with a food that is made with particular spices is not sufficient to show that consumers would assume that wine and seasoning would emanate from the same source.

With respect to the third-party registrations, we have already pointed out that most do not have any or have very little probative value.<sup>24</sup> The registrations that include both wine and spices or seasoning are quite limited:

Registration No. 2672670 for VILLA PANDOLFELLI and design (inter alia, wine and seasonings); Registration No. 2203786 for CANARIO and design (inter alia, wine, seasoning and minced garlic); Registration No. 1286155 for HONG MEI and design (inter alia, wines, table salt and MSG) and two registrations, discussed supra, owned by Cipriani Group, Inc., for CIPRIANI FOOD and for a design mark and covering a

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<sup>24</sup> See footnote 18; the discussion supra at p. 38 regarding Registration Nos. 2273272 for SEREGO ALIGHIERI, 2104535 for MARCHESI INCISA DELLA ROCCHETTA and 2237004 for DEMEL and design; the discussion supra at 40 regarding Registration No. 1553878 for SPORTSERVICE (which includes salt and pepper in addition to, inter alia, hamburger sandwiches, managing food, beverage,



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range of food products, including, inter alia, "meat extracts; preserved dried and cooked fruits and vegetables; jellies; jams; eggs, milk, and other dairy products (excluding ice cream, ice milk and frozen yogurt), edible oils and fats; fruit preserves, pickles" in addition to pepper and spices. There is also a registration, No. 1383865 for LA TASTE, but it covers, in addition to food items including spices and wine, bath oil, toilet water and shampoo. Because of the range of goods in the latter registration, it is of little probative value in demonstrating that all the goods listed therein are related. All in all, we cannot conclude from the limited number of third-party registrations that it is common for parties to sell both wine and spices, and to sell them under a single mark.

Petitioner has submitted 38 pages from Internet websites (exhibit 4 to Fondiller dep.) with advertising/ordering information for a large number of gift baskets that contain wine, along with other goods such as cheese, wine glasses, crackers, candy, cookies and smoked almonds. After a thorough review of all of the items listed in the various gift baskets, we have found only two that include what can be characterized as wine and seasonings: "The Chef's Bowl" lists sherry, garlic paste and "Flavor

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program distribution, and vending machine rental services and

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Bank Pepper Royale" along with, inter alia, pasta sauce, olive oil, tomato paste, romano cheese and a chocolate bar; "That's a Italian!" contains Italian wine and a jar of minced garlic along with, inter alia, marinara sauce, olive oil and candy. This very limited number of baskets in which spices are included along with wine is not sufficient for us to conclude that spices and wine would be viewed as complementary products.

Thus, after reviewing all the evidence of record, we are hard pressed to find that wine and seasonings are related. Moreover, to the extent that this factor slightly favors petitioner, it is far outweighed by the differences in the marks, as discussed below.

As previously noted, the registration includes a statement that "The English translation of the Patois term 'ti' is 'little.' The English translation of the Indonesian term 'moto' is 'seasoning.'" Our analysis of the similarity of the marks must therefore take into consideration the doctrine of foreign equivalents, in which foreign words from common languages are translated into English to determine their degree of confusing similarity to English word marks. See *In re Ness & Co.*, 18 USPQ2d 1815 (TTAB 1991). Respondent's mark presents a somewhat unusual situation, however, because it consists of words in two different

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photographic services).

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"languages," Indonesian and Patois. We take judicial notice that "patois" is defined both as "any subliterate regional French dialect" and "any regional dialect."<sup>25</sup> If we view TI as being a word in a French dialect, someone who speaks Indonesian is not likely to understand the TI portion of the mark, and would view the mark as the arbitrary words SIMI TI with the generic term for "seasoning" appended to it. For such Indonesian-speaking consumers, such a mark has a very different connotation and commercial impression from SIMI per se. However, if the "any regional dialect" definition of Patois applies, TI could be considered a word in a regional Indonesian dialect. If such consumers did not also speak Indonesian, they would see the mark as composed of the arbitrary terms SIMI and MOTO, and perhaps would view TI as meaning "little" or, more likely, would not ascribe any meaning to TI because it is in the middle of, to them, two "nonsense" words. Only a consumer who speaks both Indonesian and this Indonesian Patois is likely to understand the mark as meaning SIMI LITTLE SEASONING, and even this is somewhat questionable, since it is unclear whether such a consumer would realize that two words from

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<sup>25</sup> The American Heritage Dictionary of the English Language, © 1970. The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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different languages/dialects were being combined in a single mark.

The difficulty in assessing the connotation or commercial impression of respondent's mark is that, based on this record, we do not know whether Indonesian speakers in the United States would be aware of the Patois term TI or, for that matter, whether Patois speakers in the United States would be aware of the Indonesian word MOTO, or whether those who understand both languages would treat the mark as being a combination of languages and view it as "SIMI LITTLE SEASONING."

In view of this uncertainty, we cannot say that SIMI and SIMI TI MOTO convey the same connotations and commercial impressions. Certainly the marks are different in appearance and pronunciation, with the TI portion of respondent's mark presenting a rhyming aspect with the SIMI portion that is totally absent in SIMI per se.

Moreover, the du Pont factor of "the extent of potential confusion, i.e., whether de minimis or substantial" is applicable to this situation, in that it would appear that a very small number of consumers in the United States would be familiar with both the Indonesian language and the Patois dialect in which TI is a word. This factor favors respondent.

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As for consumers in the United States who are unfamiliar with either the Indonesian word "MOTO" or the Patois term "TI," SIMI TI MOTO differs significantly from SIMI in appearance, sound, connotation and commercial impression. Although respondent's mark does contain the element SIMI, the terms TI and MOTO change the impression of the mark. Not only does the element TI add a rhyming component to SIMI, but MOTO, with its two consonants each followed by the same vowel, mimics the structure of the initial element SIMI. As a result, SIMI TI MOTO will be viewed as a unitary mark, rather than as SIMI with other elements added to it. Thus, the factor of the similarity or dissimilarity of the marks favors respondent.

Accordingly, after considering all of the applicable du Pont factors, we find that petitioner has failed to prove that SIMI TI MOTO for seasoning is likely to cause confusion with petitioner's mark SIMI for wine.

Decision: The petition for cancellation with respect to Registration No 2389146 for SIMI in stylized form for, inter alia, wine vinegar (Cancellation No. 92031424), is granted; the petitions for cancellation of Registration No. 2219750 for the mark SIMI in Class 29 (Cancellation No. 92031877) and in Class 32 (Cancellation No. 92030168) and for cancellation of Registration No. 2220628 for SIMI DOCTOR

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(Cancellation No. 92031786) and Registration No. 2226361 for SIMI TI MOTO (Cancellation No. 92031728) are dismissed.